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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/081,830	02/21/2002	Jonathan M. Walsh	10559/574001/P12788	3107

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FISH & RICHARDSON, PC  
12390 EL CAMINO REAL  
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EXAMINER
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SHAW, PELING ANDY

ART UNIT	PAPER NUMBER
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2144

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/081,830	<b>Applicant(s)</b> JONATHAN WALSH	
	<b>Examiner</b> Peling A. Shaw	<b>Art Unit</b> 2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 February 2002 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/06/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Priority***

1. This application has no priority claim made. The filing date is 02/21/2002.

### ***Specification***

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if

the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The disclosure is objected to because of the following informalities:
  - a. There is no "BRIEF SUMMARY OF THE INVENTION" section.

Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Gardner et

al. (US 6580697 B1), hereinafter referred as Gardner.

- a. Regarding claim 1, Gardner disclosed a method of configuring communications over a network comprising: connecting a device to the network (column 1, line 14-24); receiving data on the device from the network (column 1, line 14-24); configuring the device for a communication mode, from a plurality of possible communication modes, wherein the communication mode includes transferring data between the device and the network simultaneously in time (column 1, line 14-24); transferring data between the device and the network based on the communication mode

(column 1, line 14-24); and determining whether to retain the device in the communication mode (column 1, line 33-46)..

- b. Regarding claim 2, Gardner disclosed the method of claim 1 further comprising, configuring the device for a communication mode, wherein the communication mode includes transferring data between the device and the network separately in time (column 3, line 26-28).
- c. Regarding claim 3, Gardner disclosed the method of claim 1, wherein communication mode further comprises a full-duplex mode (column 3, line 22-26).
- d. Regarding claim 4, Gardner disclosed the method of claim 1, wherein the network comprises an Ethernet network (column 3, line 15-20).
- e. Regarding claim 5, Gardner disclosed the method of claim 1, wherein the device comprises a medium access controller (column 3, line 15-20: Ethernet).
- f. Regarding claim 6, Gardner disclosed the method of claim 1, wherein the device comprises a switch (column 3, line 15-20).
- g. Regarding claim 7, Gardner disclosed the method of claim 1, wherein the device comprises a hub (column 3, line 15-20: switch is also a hub).
- h. Regarding claim 8, Gardner disclosed the method of claim 1, wherein the device comprises an Ethernet interface card (column 3, line 15-20).

- i. Regarding claim 9, Gardner disclosed the method of claim 1, wherein the device comprises a computer (column 3, line 15-20: a computer with Ethernet interface is a network device).
- j. Regarding claim 10, Gardner disclosed the method of claim 1, wherein the device comprises an Ethernet peripheral device (column 3, line 15-20: a Ethernet interface is considered as a peripheral to a computer, switch or network device).
- k. Regarding claim 11, Gardner disclosed an apparatus configured to connect to a network (column 3, line 15-20), the apparatus comprising: a memory which stores instructions to, configure the apparatus for a communication mode, from a plurality of possible communication modes, wherein the communication mode includes transferring data between the device and the network simultaneously in time (column 1, line 14-24), transfer data between the apparatus and the network based on the communication mode (column 1, line 14-24), determine whether to retain the apparatus in the communication mode (column 1, line 14-24); and a processor which executes the instructions.
- l. Regarding claim 12, Gardner disclosed the apparatus of claim 11, wherein the instructions include configuring the apparatus for a communication mode, wherein the communication mode includes transferring data between the apparatus and the network separately in time (column 3, line 26-28).

- m. Regarding claim 13, Gardner disclosed the apparatus of claim 11, wherein the instructions include transferring data between the apparatus and the network in a full-duplex mode (column 3, line 22-26).
- n. Regarding claim 14, Gardner disclosed the apparatus of claim 11, wherein the network comprises an Ethernet network (column 3, line 15-20).
- o. Regarding claim 15, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into a medium access controller (column 3, line 15-20: Ethernet).
- p. Regarding claim 16, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into a switch (column 3, line 15-20).
- q. Regarding claim 17, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into a hub (column 3, line 15-20: switch is also a hub).
- r. Regarding claim 18, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into an Ethernet interface card (column 3, line 15-20).
- s. Regarding claim 19, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into a computer (column 3, line 15-20: a computer with Ethernet interface is a network device).
- t. Regarding claim 20, Gardner disclosed the apparatus of claim 11, wherein the apparatus is incorporated into an Ethernet peripheral device (column 3,

line 15-20: a Ethernet interface is considered as a peripheral to a computer, switch or network device).

- u. Regarding claim 21, Gardner disclosed an article comprising a machine-readable medium that stores instructions (column 3, line 15-20) that cause a machine to: receive data from a connected network (column 1, line 14-24); configure the machine for a communication mode, from a plurality of possible communication modes, for transferring data between the machine and the network, wherein the communication mode includes transferring data between the machine and the network simultaneously in time (column 1, line 14-24); transfer data between the machine and the network based on the determined communication mode (column 1, line 14-24); and determine whether to retain the machine in the communication mode (column 1, line 33-46).
- v. Regarding claim 22, Gardner disclosed the machine-readable medium of claim 21, wherein the instructions further cause the machine to determine a communication mode, from the plurality of possible communication modes, wherein the communication mode includes transferring data between the machine and the network separately in time (column 3, line 36-46).
- w. Regarding claim 23, Gardner disclosed the machine-readable medium of claim 21, wherein the instructions further cause the machine to determine a communication mode, from the plurality of possible communication modes,



wherein the communication mode includes transferring data between the machine and the network in a full-duplex mode (column 3, line 36-46).

- x. Regarding claim 24, Gardner disclosed the machine-readable medium of claim 21 is a random access memory (column 3, line 15-20: a computer with Ethernet interface).
- y. Regarding claim 25, Gardner disclosed the machine-readable medium of claim 21 is a read only memory (column 3, line 15-20: a computer with Ethernet interface).
- z. Regarding claim 26, Gardner disclosed the machine-readable medium of claim 21 is a hard disk drive (column 3, line 15-20: a computer with Ethernet interface).

Gardner disclosed all limitations of claims 1-26. Claims 1-26 are rejected under 35 U.S.C. 102(e).

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***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Refer to the enclosed PTO-892 for details.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peling A. Shaw whose telephone number is (571) 272-7968. The examiner can normally be reached on M-F 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (571) 272-3925. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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